

REMARKS

Claims 1-16 are pending in the application.

Claims 7-9 are found to contain allowable subject matter.

Claims 2, and 15-16 have been cancelled herein.

The title of the invention is objected to as not being descriptive. A new title is proposed herein. Should this title not be acceptable, the Examiner is invited to propose a new title.

Claims 1, 10 and 11 have been amended herein to clarify applicant's claimed invention.

The claimed invention includes for example a path set-up means establishing a loop-shaped protection path that includes a part or whole of transmission links of an existing working path and would allow transmission data to flow in the opposite direction to that of the working path and wherein the path set-up means establishes the loop-shaped protection path by selecting one particular node on the working path and then drawing a closed-loop path that starts from the selected node and returns to the same selected node.

Claims 1, 10, 15 and 16 are rejected under 35 U.S.C. § 102(e) as anticipated by Dantu et al. (U.S. 6,532,088)(hereinafter Dantu). Claims 2-6 and 12-14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dantu.

In reviewing the claimed invention compared to the prior art cited in the Office Action, it appears that the path set up means in the claimed invention is argued to be equivalent to the working path and protection path in the reference.

However applicant's claimed invention includes at least the feature of establishing a loop-shaped protection path by selecting one particular node on the working path and then drawing a closed-loop path that starts from the selected node and returns to the same selected node.

In reviewing Dantu there is no description or suggestion of these feature nor the combination of features. Dantu fails to disclose the function of the path set-up means. This is admitted in the Office Action that Dantu fails to disclose the function of the path set-up means but it is argued that one skilled in the art would recognize such.

However, applicant's disagree and cannot judge this assertion nor the required motivation since no reference was provided. The only such suggestion provided has been from applicant's own disclosure. The Office Action only recites that it is "obvious" without providing any reference to judge this assertion by.

Further applicant claims a unique combination of features which is not addressed by the assertion without a reference. In the reference Dantu there is no suggestion which would lead one skilled in the art to make such a combination of prior art. Thus even if all the elements were present in the cited references (or knowledge to one skilled in the art), it is well-established that a combination of limitations, some of which separately may be known, may be a new combination of limitations which is nonobvious under the condition of 35 U.S.C. 103.

Moreover, "an examiner may often find every element of a claimed invention in the prior art." *In re Rouffet*, 47 USPQ3d 1453, 1457 (Fed. Cir. 1998) (reversing PTO obviousness rejection based on lack of suggestion or motivation to combine reference). Therefore even if every element of a claimed invention is in the combined prior art there must be some suggestion or motivation to combine the references. "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form must nevertheless be clear and particularity." *In re Dembiscak*, 175 F.3d 994, 999 (CAFC 1999).

It is respectfully submitted that a prima facie case of obviousness is not established according to the Office Action. "For a prima facie case of obviousness to exist, there must be some objective teaching in the prior art or ... knowledge generally available to one of ordinary skill in the art [that] would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). "The motivation, suggestion or teaching may come explicitly from 1) statements in the prior art, 2) the knowledge of one of ordinary skill in the art, or 3) in some cases the nature of the problem to be solved." In re Kozab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (emphasis added).

Analyzing the current application in accordance with the Federal Circuit's roadmap as outlined above, there is no suggestion that a skilled artisan to arrive at the present invention. In other words, the second prong of the above test is inapplicable here. "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kozab, 1371. It appears that no findings have been offered in the Office Action as to the skilled artisan level.

Therefore, it is submitted that Dantu fails to suggest the combination of the claimed features and the rejection has not been established with the required specificity.

Claims 1, 10 and 11 are not anticipated by the reference and should not be considered as being obvious from the reference. It is respectfully requested the rejections be withdrawn and the claims allowed.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Brian S. Myers
Reg. No. 46,947

CUSTOMER NUMBER 026304

Telephone: (212) 940-8800

Fax: (212) 940-8986/8987

Docket No.: FUJR 19.479 (100794-00200)

BSM:rm